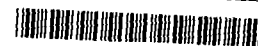


TTAB

United States Patent and Trademark Office
Before the Trademark Trial and Appeal Board



08-29-2001

U.S. Patent & TMO/TM Mail Rpt Dt. #74

Appellant: AVANT Immunotherapeutics, Inc.
Serial No: 75/496494
Mark: AVANT IMMUNOTHERAPEUTICS
Int'l Class: 005

Examining Attorney:
Marlene D. Bell
Law Office 105

Atty. Docket No.: TCS-802 US

BOX TTAB
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

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TRANSMITTAL LETTER

Transmitted herewith are three (3) copies of Appellant's Reply Brief under 37 C.F.R. §2.142(b)(1) for filing with the Trademark Trial and Appeal Board in connection with the above-identified trademark application.

The Commissioner of Patents and Trademarks is hereby authorized to charge any fees due in connection with the filing of this Reply Brief to PTO Deposit Account 50-0268.

Respectfully submitted,

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TRADEMARK LAW OFFICE 105
Serial Number: 75/496494
Mark: AVANT IMMUNOTHERAPEUTICS
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Reply Brief

This paper is Appellant's reply brief, which is being filed within twenty days of the Examining Attorney's appeal brief, mailed August 6, 2001.

FACTS

Appellant seeks to register its mark, AVANT IMMUNOTHERAPEUTICS, as applied to goods identified as: "pharmaceuticals for therapeutic and diagnostic uses in the treatment of cardiovascular disease, immune disorders, and inflammation; vaccines and purified proteins for therapeutic and diagnostic use, all in Class 5".

The Examining Attorney's brief at page 2 incorrectly includes descriptions of goods and services in Class 40 and Class 42. In Appellant's Amendment and Request for Reconsideration filed December 27, 2000, the present application was amended to recite only goods in Class 5 and to delete the recitations quoted by the Examining Attorney.

The registration of AVANT IMMUNOTHERAPEUTICS has been finally refused under 15 U.S.C. 1052(d) in view of the existing registration of the mark, AVANTI, applied to "biochemical for pharmaceutical use, namely phospholipids for use as an additive or concipient in pharmaceuticals." The Examining Attorney alleges that AVANT IMMUNOTHERAPEUTICS and AVANTI are so similar and the goods to which said marks are respectively applied are so closely related that there exists a likelihood of confusion, mistake or deception within the meaning of 15 U.S.C. 1052(d).

ARGUMENT

The Examining Attorney relies on *In re DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) as authority for the factors to be used in assessing likelihood of confusion. That decision sets for the test as follows:

- "In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered:
- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
 - (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
 - (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
 - (4) The conditions under which and buyers to whom sales are made, i. e. "impulse" vs. careful, sophisticated purchasing.
 - (5) The fame of the prior mark (sales, advertising, length of use).
 - (6) The number and nature of similar marks in use on similar goods.
 - (7) The nature and extent of any actual confusion.
 - (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
 - (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
 - (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere "consent" to register or use.
 - (b) agreement provisions designed to preclude confusion, i. e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
 - (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
 - (12) The extent of potential confusion, i. e., whether *de minimis*

or substantial.

(13) Any other established fact probative of the effect of use."
476 F.2d at 1361.

In the *In re DuPont* case, the CCPA reversed the refusal to register RALLY as applied to automotive cleaning products in view of the identical registered mark RALLY, applied to general purpose cleaning products. The Court held:

"We find no warrant, in the statute or elsewhere, for discarding *any* evidence bearing on the question of likelihood of confusion. Reasonable men may differ as to the *weight* to give specific evidentiary elements in a particular case. In one case it will indicate that confusion is unlikely; in the next it will not. In neither case is it helpful or necessary to inject broad maxims or references to 'the public interest' which do not aid in deciding. Only the facts can do that. In every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of *all* the evidence, whether or not confusion appears likely. That determination ends the decisional process.

"Decision

"Applying the above criteria, and after a thorough review of the entire record, we are convinced that confusion is not likely. The agreement and assignment herein constitute far more than mere 'consent.' They play, in this case, a dominant role."
476 F.2d at 1362.

Thus, in *In re DuPont*, identical marks on similar goods were permitted to be registered on the basis of evidence of consent between the parties, which the Court regarded as playing, in that case, "a dominant role."

The Examining Attorney in the present appeal regards "similarity of the marks, similarity of the goods and services, and similarity of trade channels of the goods and services" as playing the dominant role here. (See, Examining Attorney's brief at page 2.)

A. THE MARKS ARE NOT SIMILAR

The Examining Attorney characterizes the similarity between the Appellant's mark and the Registrant's mark as follows:

"The Applicant has merely deleted the letter 'I' from the end of Registrant's mark along with the addition of the descriptive term IMMUNOTHERAPEUTICS" (Examining Attorney's brief at page 3.)

1) THE EXAMINING ATTORNEY'S ANALYSIS IS FLAWED

First of all, the analysis of Appellant's mark by the Examining Attorney is erroneous: it unfairly presumes the mechanical derivation of Appellant's mark from the Registrant's by removal of letters and addition of terms, where there is no evidence of such derivation in the record. Moreover, the presumption of derivation of one mark from the other implies that Appellant has an intention to appropriate the commercial impression obtained from AVANTI and to deceive the consumer through the adoption of AVANT IMMUNOTHERAPEUTICS. There is also no evidence on this record of such an intention.

The connection between the spellings of the two marks at issue is drawn by the Examining Attorney and does not arise from any derivation performed by Appellant. The same derivation analysis employed by the Examining Attorney would prevent the co-registration of such marks as EVEREX and EVEREADY, or CHEVRON and CHEVROLET.

2) COMMERCIAL IMPRESSION ADDED BY INCLUSION OF
"IMMUNOTHERAPEUTICS" IS NOT IRRELEVANT

The Examining Attorney argues that the 7-syllable technical term, IMMUNOTHERAPEUTICS, is "less significant" than the AVANT portion of Appellant's mark. (See, Examining Attorney's brief at page 4.) The word IMMUNOTHERAPEUTICS has been disclaimed as descriptive apart from its use in the mark as a whole, but the fact that the term has been disclaimed **does not strip it of its ability to make a commercial impression on a consumer.**

In the composite mark AVANT IMMUNOTHERAPEUTICS, the term IMMUNOTHERAPEUTICS contributes a significant commercial impression that is completely absent in any commercial impression communicated by the registered mark, AVANTI. The impression of science and medicine, of immunology and therapy, all arise from the merest consideration of the term IMMUNOTHERAPEUTICS; and those impressions cannot arise from consideration of the Registrant's mark, which is a single-word mark.

3) OTHER *DUPONT* FACTORS WERE NOT CONSIDERED BY THE
EXAMINING ATTORNEY

The Examining Attorney's assessment of confusing similarity focuses on the similarity of appearance deriving from the identity of the first five letters of the Appellant's and the Registrant's mark. However, the holding of the case the Examining Attorney relies on to recall

the standards for assessing similarity of marks requires more points of comparison than have been assessed in this case:

"In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered:
(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. ..." *In re DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973).

Similarity in appearance of the first five letters has been assessed by the Examining Attorney, but differences in sound, connotation and commercial impression have not.

The dissimilarities in pronunciation, word origin, translated word meaning, and connotation are discussed in detail in Appellant's brief at page 4. In addition, as pointed out above, the similarity of appearance of the so-called dominant portions of the marks is effectively dispelled by the inclusion in Appellant's mark of the term IMMUNOTHERAPEUTICS, which term lends the composite mark a completely different connotation and leads to a completely unique commercial impression. See, *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986).

Accordingly, on consideration of all points of similarity or dissimilarity between the marks, as required under the test of *In re DuPont de Nemours & Co.*, Appellant's and Registrant's marks are seen NOT to be similar, and their concurrent use cannot lead to a likelihood of confusion.

**B. THE GOODS OF APPELLANT AND REGISTRANT ARE NOT SIMILAR
AND DO NOT TRAVEL IN THE SAME CHANNELS OF TRADE**

The goods of Appellant are

"Pharmaceuticals for therapeutic and diagnostic uses in the treatment of cardiovascular disease, immune disorders, and inflammation; vaccines and purified proteins for therapeutic and medical diagnostic use."

The goods of Registrant are

"Biochemical for pharmaceutical use, namely phospholipids for use as an additive or concipient in pharmaceuticals."

The distinctions between the Appellant's goods and Registrant's goods are discussed in detail in Appellant's brief at page 5. Essentially, Appellant points out that its goods are

pharmaceutically and therapeutically **active** ingredients, whereas Registrant's goods are **inactive** additives. This is the basis for concluding that the goods are not similar.

Appellant also points out that, as pharmaceuticals, the purchase of its goods is highly regulated, whereas the purchase of Registrant's goods is not. This is the basis for concluding that the goods are not encountered in the same channels of trade, just as liquors move in different channels of trade from bottled water.

These distinctions are apparent from the descriptions of goods appearing in Appellant's application and Registrant's registration, respectively.

The Examining Attorney argues, in the Examining Attorney's brief at page 6:

"The Applicant asserts that the Registrant's goods, namely, phospholipid materials are bought and sold in bulk *for a range of possible uses*. As the wording *for a range of possible uses* is significantly broad, it would be safe to presume that the goods and services of the Applicant and the goods of the Registrant are likely to be marketed and encountered by the same class of purchasers. This relationship and proximity could then give rise to the mistaken belief that the good[s] and services come from a common source." (emphasis in original)

There is no evidence in this record that the Appellant's goods and the Registrant's goods are encountered by the same class of purchasers. That the goods themselves are different is apparent from the respective descriptions of goods, which **are** on the record.

Appellant's conclusion from the description of Registrant's goods that the phospholipids might have a range of possible uses is not evidence of their **actual** use, nor is it evidence of where such materials might be sold or to whom they might be sold. Accordingly, it is NOT "safe to presume" from an argument of Appellant's brief where and how the goods of the Registrant are "likely to be marketed and encountered". Nor is it fair for the Examining Attorney to "presume" the same class of purchasers for Appellant's and Registrant's goods without evidence.

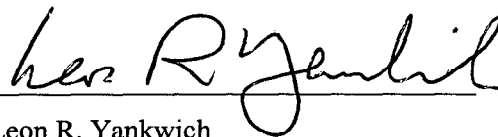
The conclusions of Appellant with respect to dissimilarity of goods and channels of trade are based on reasonable conclusions from the official descriptions of goods submitted to the Trademark Office (under oath); the conclusions of the Examining Attorney are respectfully submitted to be based on presumption and imagined probability, without a foundation in actual facts from the record before the Board. Consequently, the Examining Attorney's conclusions that the goods of Appellant and Registrant are similar and that such goods will be encountered by the same consumers are erroneous.

CONCLUSIONS

For the reasons set forth in Appellant's brief, the mark AVANT IMMUNOTHERAPEUTICS is seen to be different in appearance, sound, derivation, meaning, connotation, and commercial impression from the cited registered mark, AVANTI. The Appellant's goods differ significantly from those of Registrant, and by virtue of federal regulation are asserted to travel in distinct channels of trade.

In view of the foregoing, registration of AVANT IMMUNOTHERAPEUTICS should not be prevented by the existing registration of AVANTI, and the Examining Attorney's final refusal should be reversed.

Respectfully submitted,

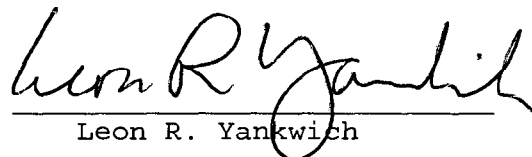


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CERTIFICATE OF MAILING

The undersigned hereby certifies that this correspondence is being deposited with the U.S. Postal Service as First Class mail, postage prepaid, in an envelope addressed to Box TTAB, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 02202-3513, on the date indicated below.

8/25/2001
date



Leon R. Yankwich